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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/995,190      | 11/26/2001  | Hong Michael Dang    | 100111410-2         | 9378             |

7590 12/22/2004  
HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527

EXAMINER

KRAMER, JAMES A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3627

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/995,190

Applicant(s)

DANG ET AL.

Examiner

James A. Kramer

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cretzler in view of Perkowski.

Cretzler teaches a system and method which collects and remits taxes at point-of-sale locations. The system includes a group of point-of-sale terminals that receive tax collection information (receiving transaction request), totals and stores the requests (storing transaction request into master request file in a database) (column 2; lines 24-35).

A bank computer at a merchant bank receives the tax collection information from the merchant and wire transfers the collected sums to the tax authority (column 2; lines 31-43). Examiner notes that the process by banks wire money to a tax authority is via TPX. Therefore, it is inherent that when the bank collects the information from the merchant it must transfer that data into a TPX-based file in order to wire transfer the money to the tax authority.

Cretzler teaches for credit and debit transactions, the system obtains approval for the intended transaction (column 4; lines 37-41). Examiner notes this represents 3<sup>rd</sup> party verification of any request prior to transaction of tax related information.

Cretzler also teaches the customer is notified of the sums received on behalf of the merchant (column 6; lines 1-5). Examiner notes that this represents allowing 3<sup>rd</sup> party review of the TXP file.

Cretzler does not specifically teach the use of an XML-based transaction request. Perkowski teaches an Internet enabled POS terminal (Figure 3A5). In addition, Perkowski teaches the terminal transmitting transaction information via XML-based files in order to utilized Internet technologies. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Cretzler to include an Internet enabled POS terminal and XML-based transaction requests as taught by Perkowski in order to utilize Internet technologies.

#### ***Response to Arguments***

Applicant's arguments filed 9/24/04 have been fully considered but they are not persuasive.

Applicant argues that the 1994 filing date of Cretzler is prior to the proliferation of the Internet in the late 1990's and therefore the skill and expertise necessary for implementing a transaction tax system over a network such as the Internet, would not have been obvious to one at the time of Cretzler (1994). Examiner notes that the requirement "at the time of the invention was made", refers to the "Claimed Invention". In other words, the argument is, at the time of Applicant's filing, could the Applicant have looked at the two reference noted in this action and reasonably come up Applicant's claimed invention? The answer is, yes. Therefore, whether or not Cretzler's invention was developed before or after the proliferation of the Internet is irrelevant to this Office Action. (reference MPEP 2141.01 (III) and MPEP 2145)

Applicant further asserts that Perkowski does not teach a method and system to transaction tax related data collection. Again, Applicant has made an argument that is not relevant to the present rejection. Examiner merely uses Perkowski to teach an Internet enabled POS terminal (Figure 3A5) and that the terminal transmitting transaction information via XML-based files. This teaching is then combined with Cretzler to teach Applicant's invention.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Kramer whose telephone number is (703) 305-5241. The examiner can normally be reached on Monday - Friday (8AM - 5PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (703) 305-4716. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Kramer  
Examiner  
Art Unit 3627

jak

*Michael Cuff* 12/20/04  
MICHAEL CUFF  
PRIMARY EXAMINER